

REMARKS/ARGUMENTS

Applicants affirm the election of claims of Group I and have canceled and/or labeled claims not within that group accordingly. Independent claims 1 and 27 have been amended to be limited to claims covering compounds of formula (I) only and libraries containing them. However, Applicants note as stated in the Office Action the possibility of rejoinder of method of use claims currently restricted out.

Applicants note with appreciation the examiner's comments about the designation of compounds in Table 1. Applicants clarify that the compound elected is compound 3 shown in the process of paragraph 768, compound 3, in which X_1 is -CH- and the other moieties are as indicated in the Election. Table 1 was meant to be a table of compounds in all of which X_1 is -CH-.

The examiner takes the position that while claims to the elected species are allowable, the claims should be restricted to such species. Applicants respectfully disagree. Applicants are entitled to generic claims, as further discussed below, and request that now that the examiner has indicated the elected species is patentable, examination proceed under MPEP 803.02 to the remainder of the generic claim. The election of species, as stated in that document, was purely provisional, and Applicants are not required to limit their claims to the elected species.

Claim 7 stands rejected for lack of antecedent for phenethyl for group R_1 in claim 1.

Phenethyl is defined by R_1 when R_1 is $R_6-X_2-C(R_8)(R_8)-R_7-$, R_6 is aryl, namely phenyl, X_2 is a direct bond, both groups R_8 are H and R_7 is -CH₂- (a C₁ alkyl group).

Claim 8 stands rejected for lack of antecedent for R_1 being 2-hydroxyethyl. R_1 is 2-hydroxyethyl when R_1 is $R_6-X_2-C(R_8)(R_8)-R_7-$, R_6 is Y, Y is hydroxymethyl, X_2 is a direct bond, both groups R_8 are hydrogen and R_7 is a direct bond.

Claim 9 stands rejected for lack of antecedent basis for R_2 being n-butyl, phenyl or n-butyrylamido.

R_2 is n-butyl when R_2 is $R_6-X_2-C(R_8)(R_8)-R_7-$, R_6 is hydrogen, X_2 is a direct bond, both R_8 groups are hydrogen and R_7 is a C₃ alkyl group. The definition of R_2 as n-butyrylamido is in error; as shown in Table 1, the correct term is 1-hydroxy-n-butyrylamido (Table 1, compounds

Appl. No. 10/826,175
Amdt. dated April 10, 2006
Reply to Office Action of January 24, 2006

PATENT

3 and 5) and is met when R₂ is R₆-X₂-C(R₈)(R₈)-R₇-, R₆ Y, Y is CONR₃R₄, R₃ and R₄ are both hydrogen, X₂ is C₃H₇, one R₈ is hydrogen and the other is hydroxyl, and R₇ is a direct bond. A review of the claim structure showed that R₂ being phenyl was in fact not included; accordingly by this amendment the definition of R₂ has been adjusted, as per claim 10, to include phenyl when m' is zero.

Applicants note that the accompanying Information Disclosure Statement includes some publications describing compounds within the scope of the current claims. However, these are publications naming various combinations of inventors according to the specific information contained in each publication, as is customary in this field, and all are within one year of the filing date of the priority application in this case, so that they do not constitute statutory bars under 35 U.S.C. 102(b).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

Joel G. Ackerman
Reg. No. 24,307

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
JA:ja
60724870 v1